

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CONRAD L. OTT, ROBERT C. CARLSON, JR.
and CHARLES MAYNARD

Appeal No. 1999-0439
Application 08/652,908

ON BRIEF

Before HAIRSTON, JERRY SMITH and BARRETT, Administrative
Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 2-8, 11-13 and 33. Claims 14-32 stand withdrawn from consideration as being directed to a non-elected invention. Claim 1 has been cancelled. Claims 9 and 10 have been indicated to contain

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allowable subject matter. An amendment after final rejection was filed on December 23, 1997 and was entered by the examiner.

The disclosed invention pertains to an adapter plate for holding cable adapters and which is mountable in an adapter plate bracket.

Representative claim 2 is reproduced as follows:

2. An adapter plate for holding cable adapters, said adapter plate being mountable in an adapter plate bracket, the adapter plate comprising:

a body portion for receiving the cable adapters, said body portion having an opening for receiving one of the cable adapters; and

at least one latching portion integral with said body portion for attaching said adapter plate to the adapter plate bracket.

The examiner relies on the following references:

Despard	1,930,610	Oct. 17, 1933
Thompson et al. (Thompson)	2,934,590	Apr. 26, 1960
Robbins	3,652,781	Mar. 28, 1972

Claims 2-8, 11-13 and 33 stand rejected under 35

U.S.C.

§ 103. As evidence of obviousness the examiner offers Thompson taken alone with respect to claims 2-7, 12 and 13, Thompson in view of Robbins with respect to claims 8 and 33,

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and Thompson in view of Despard with respect to claim 11.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does not support the rejections as set forth by the examiner. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of

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the

arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

We consider first the rejection of claims 2-7, 12 and 13 based on the teachings of Thompson taken alone. These claims stand or fall together as a single group [brief, page 3]. With respect to representative, independent claim 2, the examiner asserts that Thompson teaches the claimed invention except for the latching portion of Thompson being integral with the body portion. The examiner finds that it would have been obvious to the artisan to make Thompson's latching portion 21 integral with Thompson's body portion 20,36 because it has been held to involve only routine skill to form an article in one piece which had formerly been formed in two pieces, citing Howard v. Detroit Stove Works, 150 U.S. 164

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(1893) [answer, pages 4-5].

Appellants argue that faceplate 36 of Thompson is intended to be removable from clip 21 so that there is no suggestion in Thompson of making the faceplate 36 integral with clips 21 and 22. Appellants also argue that if the faceplate was integral with the clips in Thompson, the receptacle could not be removed which would destroy the accessibility sought by Thompson. Finally, appellants argue that the examiner's reliance on Howard is misplaced under the facts of this case [brief, pages 4-5]. The examiner disagrees with each of these arguments [answer, pages 9-10].

We agree with the position argued by appellants. Although Thompson would appear to be substantially unrelated to the invention disclosed by appellants, it is clear that the examiner has interpreted claim 2 so broadly that the examiner finds the invention as recited in claim 2 to be substantially met by Thompson. Appellants and the examiner have permitted the disposition of this case to be decided on the single question of whether it would have been obvious within the meaning of 35 U.S.C. § 103 to make the latching portion 21 of Thompson integral with the body portion 20,36.

We simply cannot accept the examiner's position that it would have been obvious for two pieces that are intended to be separable to be made into a single piece. The examiner is effectively applying a per se rule of obviousness. While there are, no doubt, many circumstances where integrating two pieces into a single piece might be obvious under 35 U.S.C. § 103, the facts of this case teach away from such modification. There would be no motivation for the artisan to modify Thompson so that latching portion 21 is integral with body portion 20,36 because that would make it impossible to get access to the electrical wiring in Thompson. The only motivation to make such a modification to Thompson would be to improperly create the claimed invention in hindsight. Since there is no proper motivation to make the modification of Thompson proposed by the examiner, we do not sustain the examiner's rejection of claims 2-7, 12 and 13.

We now consider the rejection of remaining claims 8, 11 and 33. Claims 8 and 11 depend from claim 2 so that the discussion above applies equally to these dependent claims. Since neither Robbins nor Despard overcomes the basic

deficiency of Thompson discussed above, we also do not sustain the examiner's rejection of claims 8 and 11.

Claim 33 is an independent claim which is rejected on the collective teachings of Thompson and Robbins. The examiner acknowledges that Thompson does not teach the first and second orientations which result in first and second oblique angles as recited in claim 33. The examiner cites Robbins as teaching an adapter which can be mounted in two orientations to yield two oblique angles. The examiner proposes to use the Robbins oblique surface with the Thompson adapter [answer, pages 7-8].

Appellants argue that the combination of Robbins with Thompson gives only a single angular orientation rather than two as claimed [brief, page 6]. Appellants also argue that Robbins teaches away from an upwardly facing orientation because Robbins is attempting to make the electrical box waterproof and an upwardly facing orientation would defeat that purpose [reply brief, pages 3-4].

We agree with the position argued by appellants for the reasons set forth in the briefs. The collective teachings of Thompson and Robbins do not suggest the two orientations

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and two oblique angles as recited in claim 33. Therefore, we do not sustain the rejection of claim 33.

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In summary, we have not sustained any of the rejections of the appealed claims as formulated by the examiner. Therefore, the decision of the examiner rejecting claims 2-8, 11-13 and 33 is reversed.

REVERSED

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KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
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LEE E. BARRETT)	
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JS:caw